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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,390	11/14/2000	Akilan Tiburtius	1000-0206	9001

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EXAMINER

PIZARRO, RICARDO M

ART UNIT PAPER NUMBER

2661

DATE MAILED: 04/21/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/712,390

Applicant(s)

TIBURTIUS ET AL.

Examiner

Ricardo M. Pizarro

Art Unit

2661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) 1-14 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4, 7-10 and 14 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5 and 6 is/are rejected.
- 7) ☒ Claim(s) 11-13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 2661

## **DETAILED ACTION**

### ***Drawings***

The informal drawings filed in this application are acceptable for examination purposes. When the application is allowed, applicant will be required to submit new formal drawings.

### ***Claim Objections***

1. Claims 3 and 11-13 are objected to because of the following informalities and it is suggested to applicant:

In claim 3 line 5 replace "a" with –the–

In claim 11 line 4 replace "a" with –the–

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Lupien.

US patent no. 6,463,055 (Lupien et al) discloses an Integrated Radio telecommunications network and method of working an ANSI-41 network and the general packet radio service, comprising a method of delivering data and real-time media from a first mobile terminal to a second mobile terminal (First and second TE terminals in

Art Unit: 2661

Fig. 5), said data being transferred through a packet-switched network ( GPRS Network in Fig. 5), and said real-time media being transferred through a circuit-switched network ( ANSI-41 network in Fig. 5), said method comprising the steps of passing the real-time media from the first mobile terminal to the second mobile terminal in a circuit switched call ( col 19 lines 65-67, col 20 lines 1-10); passing the data from the first mobile terminal to the second mobile terminal in a packet-switched data session ( col 19 lines 65-67, col 20 lines 1-10); associating the circuit-switched call with the data session in the second mobile terminal using binding information passed from the first mobile terminal to the second mobile terminal ( binding ID information i.e. IMSI col 3 lines 56); and simultaneously presenting the real-time media and the data to a user of the second mobile terminal ( simultaneous presentation col 7 lines 34-55), as in claim 1; wherein the mobile terminals are Class-A mobile terminals, and the step of passing the data from the first mobile terminal to the second mobile terminal in a packet-switched data session is performed while the circuit-switched call is on-going ( col 19 lines 65-67, col 20 lines 1-10), as in claim 2; wherein the mobile terminals are Class-B mobile terminals, and the step of passing the data from the first mobile terminal to the second mobile terminal in a packet-switched data session is performed before the circuit-switched call is originated( col 19 lines 65-67, col 20 lines 1-10), as in claim 3.

3. Claims 5-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Lupien.

US patent no. 6,463,055 ( Lupien et al) discloses an Integrated Radio telecommunications network and method of working an ANSI-41 network and the general packet radio service, comprising a method of delivering data and real-time media from a first Class-A mobile terminal to a second Class-A mobile terminal ( First and second TE terminals in Fig. 5), said data being transferred through a packet-switched network ( GPRS Network in Fig. 5), and said real-time media being transferred through a circuit-switched network ( ANSI-41 network in Fig. 5), said method comprising the steps of: setting up a circuit-switched call to pass the real-time media from the first mobile terminal to the second mobile terminal ( col 19 lines 65-67, col 20 lines 1-10); setting up a packet-switched data session during the circuit-switched call to pass the data from the first mobile terminal

Art Unit: 2661

to the second mobile terminal ( col 19 lines 65-67, col 20 lines 1-10); associating the data session with the circuit- switched call in the second mobile terminal using binding information passed from the first mobile terminal to the second mobile terminal ( binding ID information i.e. IMSI col 3 lines 56); and simultaneously presenting the real-time media and the data to a user of the second mobile terminal( simultaneous presentation col 7 lines 34-55), as in claim 5; wherein the step of setting up a circuit-switched call includes setting up a voice call ( col 30 lines 8-12), as in claim 6.

***Allowable Subject Matter***

4. Claim 4, 7-10 and 14 are allowed.
5. Claim 11 –13 would be allowable if rewritten or amended to overcome injection to claims under 37 CFR 1.75.

***Conclusion***

**6. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9314

(for formal communications intended for entry, for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).

Art Unit: 2661

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Ricardo Pizarro** whose telephone number is (703) 305-1121. The examiner can normally be reached on Monday-Friday from 9:00 AM to 5:30 PM. The fax number for this Group is (703) 872-9314.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Douglas Olms**, can be reached on (703) 305-4703.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

4/6/2004

*Ricardo M. Pizarro*

*Douglas W. Olms*

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